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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

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DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,264

Applicant(s)

DE ANGELIS

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has as the final step "evaluating on the basis of this comparison the presence and concentration of MTBE". The claim fails to set forth how the comparison is to be used in determining the presence and concentration of MTBE. How does the user use the comparison of resistance variations to determine the presence of MTBE?

Also in claim 1, Applicants state "sensors consisting of" and lists two components (sensitive element and heater). Applicants further state that the signals from the sensor are compared and evaluated. The "consisting of" language is closed language and does not allow other components to be present. However, it is evident that additional components (i.e. means for comparing the signal) are necessary for carrying out the claimed method. Applicants' should either use "comprising" language or add additional components that would perform the method steps to claim 1.

Claims 2 and 4 contain the phrase "characterized in that", which is unconventional in US patent practice. Applicants should use "wherein" in its place.

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Claim 3 contains method steps which do not appear to be pertinent to the device claim.

Applicants should delete the steps of "comparing the signals..." and "evaluating..."

There is insufficient antecedent basis for "the variations in resistance" in claim 3.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,811,662 to Williams et al.

Williams et al '662 teach a gas sensor for sensing ozone, as well as carbon monoxide, hydrocarbons, hydrogen and ethanol (col. 4, lines 15-20). The sensor comprises a metal oxide substrate (70) having metallic electrodes (72) on one of its sides. On the other side of the substrate, a heating element (78) is disposed (col. 8, lines 11-17). The electrodes are metallic material such as platinum (col. 8, lines 40-42). The sensor may be disposed in housing (94). The housing contains a cap (102) fitting around the outer wall of the sensor and having slots which allow gases to be admitted. The slot containing cap is equivalent to Applicants' membrane. Regarding the thickness of the sensing layer, Williams et al '662 teach that the thickness is preferably 40 microns (col. 10, lines 23-26). Further provided is a resistance measuring circuit (124) for processing the sensor output signals and producing output signals representing the sensor resistance. This resistance measuring circuit is equivalent to Applicants' electronic evaluation system.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al '662 in view of US Patent 5,573,728 to Loesch et al.

Williams et al '662 disclose at col. 8, lines 50-54 that the sensing substrate may be made of any suitable metal oxide. However, Williams et al '662 fail to specially teach tin oxide.

Loesch et al '728 teach a gas sensing device similar to that disclosed by Williams et al '662. The device contains a semiconductor element (4) and a heating element (2). Metal electrodes of platinum are disposed on one side of the element. As the semiconductor element, Loesch et al '728 teach the use of tin oxide (col. 3, lines 53-57). It would have been obvious to one of ordinary skill in the art to use tin oxide as the sensing element of the device of Williams et al '662, to provide a device which is sensitive to the presence of gas and provide an indication of such.

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Therefore for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Williams et al and Loesch et al.

*Allowable Subject Matter*

9. Claims 1 and 2 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The prior art of record does not teach or suggest the use of metal oxide sensing element having a heating element for determining the presence of MTBE, wherein one sensing element is disposed in the ground and another disposed in the air, and wherein a comparison of the resistance variations is used to determine the presence of MTBE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


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LIC

June 28, 2002

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700